

REMARKS

Applicant has studied the Office Action dated June 28, 2006. Claims 1, 2, 4-6 and 11-19 are pending. Claims 1, 11, 17 and 19 are independent claims. Claims 1, 4, 14-17 and 19 have been amended. Claim 7 has been canceled without prejudice. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

§ 103 Rejections

Claims 1, 4 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck et al. ("Roeck" U.S. Pat .No. 6,574,796) in view of DiNatale et al. ("DiNatale" WIPO Pub. No. WO 02/48897 A1) in view of Fawcett (U.S. Pat. No. 5,845,077). This rejection is respectfully traversed.

It is respectfully noted that claim 7 has been canceled without prejudice with this paper. It is therefore, respectfully submitted that the rejection is now moot with regard to claim 7 and it is respectfully requested that the rejection of claim 7 be withdrawn.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is respectfully noted that the Examiner, at page 4 of the Office Action, indicates that "Roeck in view of DiNatale ... fails to teach of downloading the file only when the file is a more recent version" and asserts that Fawcett teaches "conducting an inventory

of the current software before proceeding to downloading the most recent version" at col. 6, ll. 12-32. It is further respectfully noted that the Examiner has not specifically identified how "conducting an inventory of the current software before proceeding to downloading the most recent version" teaches the claim 1 recitation of storing of the detected configuration only when the detected configuration file is a more recent version than a configuration file previously stored in the non-volatile memory and it is respectfully submitted that asserted combination of references is not only improper, but even if considered, the teachings of Fawcett fail to cure the Examiner's indicated deficiency of Roeck and DiNatale.

It is respectfully noted that the present invention and the claims under consideration as well as the Roeck and DiNatale inventions are directed to the initialization of a cable modem. It is further respectfully noted that the present invention is specifically directed to "shortening the time required" for initializing a cable modem. See specification at pg. 1, ll. 7-9, and pg. 5, ll. 15-19. It is respectfully submitted that neither the specification and claims of the present invention nor Roeck and DiNatale disclose any user involvement in the cable modem initialization process. It is further respectfully submitted that requiring a user to participate in the cable initialization process would be contrary to the stated intent of the present invention of "shortening the time required" for initializing a cable modem.

On the other hand, it is respectfully noted that Fawcett is directed to a process for updating software installed on a computer that is performed after "an update service at a remote location" is accessed with, for example, a "modem" and the process further requires "a user" to both initiate the update process and to confirm any software updates that are performed. Col. 2, ll. 24-45, col. 5, ll. 29-47, col. 5, line 61, to col. 6, line 32, col. 6, ll. 50-55, col. 8, ll. 26-30. It is further respectfully noted that Fawcett specifically discloses that "No software is downloaded without the user's permission" at col. 8, ll. 29-30.

It is well-settled that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of the applicants' specification) to make the necessary changes in the disclosed device. The mere fact that a reference may be

modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

The Examiner bears the burden of establishing the existence of either 1) some objective teaching in the prior art or 2) knowledge generally available to one of ordinary skill in the art which would lead that individual to change the primary reference. In re Jones, 21 USPQ2d 1941, 1943-44 (Fed. Cir. 1992). Section 103 does not allow the Examiner to engage in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. In re Wesslau, 147 USPQ 391 (CCPA 1975).

As the CAFC has said, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984). Indeed, it is not proper under 35 U.S.C. 103 to modify a prior art patent in a manner which would destroy that on which the invention of the prior art patent was based. Ex parte Hartman, 186 USPQ 366, 367 (PTO Bd. App. 1974).

It is respectfully submitted that one of ordinary skill in the art would **not** be motivated to modify the combination of the Roeck and DiNatale inventions, which disclose no user involvement in the modem initialization process, by the teachings of Fawcett, which requires a user's involvement and specifically requires "the user's permission" before any software is downloaded in order to attain the stated goal of the present invention of "shortening the time required" for initializing a cable modem. It is further respectfully submitted that to modify the combination of the Roeck and DiNatale inventions according to the teachings of Fawcett would "destroy" that on which the Roeck and DiNatale inventions are based by requiring user involvement in the modem initialization process.

In view of the preceding arguments, it is respectfully asserted that the combination of the Roeck, DiNatale and Fawcett references is improper and it is respectfully requested that the rejection be withdrawn.

It is respectfully noted the Examiner, at pages 16-17 of the present Office Action, responds to the aforementioned remarks, which were previously ~~made with respect to the Fawcett reference~~ in the response to the previous Office Action, by simply re-phrasing the previous assertion with regard to Fawcett. It is further respectfully noted that the Examiner has failed to address the specific remarks made with regard to Fawcett.

Specifically, as re-iterated here, it has been respectfully submitted that Fawcett requires "a user" to both initiate the update process and to confirm any software updates that are performed, while neither the present invention nor Roeck and DiNatale disclose any user involvement in the cable modem initialization process and, since requiring a user to participate in the cable initialization process would be contrary to the stated intent of the present invention of "shortening the time required" for initializing a cable modem, one of ordinary skill in the art would **not** be motivated to modify the combination of the Roeck and DiNatale inventions by the teachings of Fawcett because, among other things, the combination of the Roeck and DiNatale inventions according to the teachings of Fawcett would "destroy" that on which the Roeck and DiNatale inventions are based. Also as re-iterated here, It has been respectfully requested that the Examiner identify how "conducting an inventory of the current software before proceeding to downloading the most recent version" teaches the claim 1 recitation of storing of the detected configuration only when the detected configuration file is a more recent version than a configuration file previously stored in the non-volatile memory. It is respectfully requested that the Examiner address the specific arguments that have been put forth with regard to the combination of the Roeck, DiNatale and Fawcett references.

Notwithstanding that the combination of the Roeck, DiNatale and Fawcett references is improper and Fawcett fails to disclose storing of the detected configuration only when the detected configuration file is a more recent version than a configuration

file previously stored in the non-volatile memory, independent claim 1 has been amended with this paper to more clearly disclose the present invention by reciting that the CPU initializes the cable modem based on the previously stored configuration file when the detected version information of the configuration file is identical to version information of the previously stored configuration file. It is respectfully submitted that, even if the combination of the Roeck and DiNatale inventions was modified by the teachings of Fawcett, the resulting invention would not result in a CPU that initializes the cable modem based on the previously stored configuration file when the detected version information of the configuration file is identical to version information of the previously stored configuration file.

It is respectfully noted that the claimed invention is directed to an apparatus and method for initializing a cable modem that is capable of reducing a time required to initialize a cable modem by only receiving version information related to a configuration file registered in the DHCP server and initializing the cable modem based on the previously stored configuration file when a comparison of the received version information with version information related to the previously stored configuration file indicates that the received version information is identical to the version information of the previously stored configuration file. It is respectfully submitted that the claimed invention can initialize the cable modem based on the previously stored configuration file without downloading a new configuration file for initializing the cable modem, thereby reducing initialization time.

It is respectfully submitted that Roeck teaches a cable modem comprising a processor configured to handle a plurality of modulation schemes and a downstream receiving component operating in conjunction with the processor and configurable by the processor to detect any one of the plurality of modulation schemes at a particular time including one or more non-default modulation schemes for a downstream channel in a cable television plant. It is further respectfully submitted that Roeck teaches amplifiers, a tuner, a media access control unit for manipulating addresses in data packet headers and a transmitter chip for modulating digital data to an analog signal for

transmission upstream. Moreover, it is respectfully submitted that Roeck fails to disclose the processor initializes the cable modem based on the previously stored configuration file when the detected version information of the configuration file is identical to version information of the previously stored configuration file.

It is respectfully submitted that DiNatale teaches an initialization process that includes downloading a configuration file that has the file name of an operating software table file, comparing the operating software table file name with the version currently stored within the cable modem, determining the latest operating software version for its class and downloading the latest operating software version if this version differs from the version currently in use. On the other hand, it is respectfully noted that the claimed invention only receives the information related to the configuration file and not the actual configuration file in order to reduce the required initialization time of the cable modem. Moreover, it is respectfully submitted that DiNatale fails to cure the deficiencies of Roeck with respect to the processor initializes the cable modem based on the previously stored configuration file when the detected version information of the configuration file is identical to version information of the previously stored configuration file.

It is respectfully submitted that Fawcett teaches a method for identifying and obtaining computer software comprising retrieving from a first computer to a second computer an inventory identifying at least certain computer software installed on the first computer, comparing the inventory of computer software with a database to identify computer software available to the first computer that is not installed on the first computer, preparing related software information for presentation at the first computer and sending the software information to the first computer, the information including an alert about a defect in software on the first computer correctable by software available to, but not yet installed on, the first computer. It is respectfully noted that the Examiner indicates, at page 4 of the Office Action, that "Fawcett teaches of conducting an inventory of the current software before proceeding to **download** the most recent version." Emphasis added. Moreover, it is respectfully submitted that Fawcett fails to cure the deficiencies of Roeck and DiNatale with respect to the processor initializes the

cable modem based on the previously stored configuration file when the detected version information of the configuration file is identical to version information of the previously stored configuration file.

It is respectfully asserted that claim 1 is allowable over the cited combination of references. It is further respectfully asserted that claim 4, which depends from claim 1, also is allowable over the cited combination of references.

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck in view of DiNatale in view of Fawcett as applied to claim 1, and further in view of Welles, II et al. ("Welles" U.S. Pat. No. 6,532,495). This rejection is respectfully traversed.

It is respectfully submitted that Welles teaches an Internet download enhancement system for downloading a file in which a downloaded file is received over either a narrow band download path or a broadband broadcast download path with selectable download options based at least on an unused bandwidth of one or more of the download paths, thereby enabling the input of a selected download option. It is further respectfully submitted that Welles fails to cure the deficiencies of Roeck, DiNatale and Fawcett with respect to the processor initializes the cable modem based on the previously stored configuration file when the detected version information of the configuration file is identical to version information of the previously stored configuration file.

Therefore, it is respectfully asserted that claim 1 is allowable over the cited combination of references. It is further respectfully asserted that claim 2 is also allowable over the cited combination of references based on its dependence from claim 1.

Claims 11, 13, 14, 16 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Fawcett. This rejection is respectfully traversed.

It is respectfully noted that independent claims 11 and 19 have been amended to recite limitations similar to those of independent claim 1. It is respectfully submitted that the previous remarks with regard to Fawcett failing to cure the deficiencies of DiNatale with respect to independent claim 1 apply to independent claims 11 and 19.

Therefore, it is respectfully asserted that claims 11 and 19 are allowable over the cited combination of references. It is further respectfully asserted that claims 13, 14 and 16 also are allowable over the cited combination of references based on their dependence from claim 11.

Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Fawcett as applied to claim 11 and further in view of Rainard. This rejection is respectfully traversed.

It is respectfully submitted that Rainard teaches recognizing a delimiter in the precursor binary data train to resynchronize the reception of information cells in the transmitted data elements. It is further respectfully submitted that Rainard fails to cure the deficiencies of DiNatale and Fawcett with respect to the processor initializes the cable modem based on the previously stored configuration file when the detected version information of the configuration file is identical to version information of the previously stored configuration file.

Therefore, it is respectfully asserted that claim 11 is allowable over the cited combination of references. It is further respectfully asserted that claim 15 is also allowable over the cited combination of references based on its dependence from claim 11.

Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck in view of DiNatale in further view of Fawcett as applied to claim 1 and further in view of Gatherer et al. ("Gatherer" U.S. Pat. No. 6,549,584) in view of Rainard. This rejection is respectfully traversed.

It is respectfully submitted that Gatherer teaches a parser which receives a bit stream and parses the incoming bit stream into m-bit symbols in consideration of the coding. It is further respectfully submitted that Gatherer fails to cure the deficiencies of Roeck, DiNatale, Fawcett and Rainard with respect to the processor initializes the cable modem based on the previously stored configuration file when the detected version information of the configuration file is identical to version information of the previously stored configuration file.

Therefore, respectfully asserted that claim 1 is allowable over the cited combination of references. It is further respectfully asserted that claims 5 and 6 are also allowable over the cited combination of references based on their dependence from claim 1.

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Fawcett as applied to claim 11 and further in view of Gatherer. This rejection is respectfully traversed.

As was previously respectfully submitted, Gatherer fails to cure the deficiencies of DiNatale and Fawcett with respect to the processor initializes the cable modem based on the previously stored configuration file when the detected version information of the configuration file is identical to version information of the previously stored configuration file. It is, therefore, respectfully asserted that claim 11 is allowable over the cited references, as is claim 12 based on its dependence from claim 11.

Claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Gatherer in view of Rainard in view of Fawcett. This rejection is respectfully traversed.

It is respectfully noted that independent claim 17 has been amended to recite limitations similar to those of independent claims 1 and 11. It is respectfully submitted that the previous remarks with regard to Gatherer, Rainard and Fawcett failing to cure the deficiencies of DiNatale with respect to independent claims 1 and 11 apply to independent claim 17. Therefore, it is respectfully asserted that claim 17 is allowable over the cited combination of references, as is claim 18 based on its dependence from claim 17.

CONCLUSION

In light of the above remarks, Applicant submits that claims 1, 2, 4-6 and 11-19 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

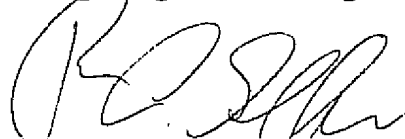
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Lee, Hong, Degerman, Kang & Schmadeka

Date: October 30, 2006

By:



Richard C. Salfelder
Registration No. 51,127
Attorney for Applicant

Customer No. 035884